

can be found on page 13 of the specification, for example. Support for amended claim 73 and 77 can be found on page 16 of the specification, for example. Accordingly, no new matter has been added, and no estoppels are intended thereby.

II. Information Disclosure Statement

The Examiner appears to have inadvertently overlooked one of the references cited on the Information Disclosure Statement filed April 6, 2001, because consideration of the reference is not indicated on the PTO-1449. A copy of this reference was filed with the Information Disclosure Statement, as evidenced by a copy of the stamped postcard submitted herewith. However, for the Examiner's convenience, enclosed is another copy of this reference for his consideration. The reference in question was cited in the International Search Report of the PCT corresponding to this national phase application. The Examiner is kindly requested to signal his consideration of this reference by initialing the PTO-1449 and providing a copy to Applicant with the next communication.

III. Claim Interpretation

The Office Action provides a separate section entitled "Claim Interpretation." Office Action at pages 3-4. Applicant respectfully objects to the Examiner's "Claim Interpretation" section because there is no legal or procedural basis for such a section, especially as it is provided outside the context of an objection or rejection.

Applicant respectfully submits that claim 27 is proper, and that the Examiner has not alleged otherwise. The Examiner's Statement is without context.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

The Examiner has pointed to one instance in the disclosure describing gel strength. However, the compositions throughout the specification and claims also teach gel strength. The Examiner's statement and further reference to MPEP § 2112 is without context.

The Examiner contends claims 85 and 86 recite intended use. Applicant respectfully submits that the scope and meaning of claims 85 and 86 are clear. The Examiner's refusal to properly consider the preamble of these claims is unwarranted.

IV. Claim Rejections - 35 USC § 112

The Examiner alleges that "several of the claims contain improper alternative groupings that should be corrected." Office Action at page 4. In particular, the Examiner notes that "and" is used several times in a single Markush group (e.g., claim 26). Respectfully, the Examiner's objection to the use of the term "and" is misplaced. The Examiner had not alleged with any specificity where lack of clarity exists in any of the elements or their combination in the Markush group of claim 26. Applicant respectfully submits that the alternative lists of elements in the Markush groups clearly define the metes and bounds of the claim.

The Examiner suggests that "applicants insert --the group consisting of-- after "chosen from." *Id.* Applicant respectfully declines the Examiner's suggestion, and submits the rejection is improper. The Examiner has shown no legal basis requiring a change to the claim language. Specifically, the Examiner relies on M.P.E.P. § 2173.05(h) for a discussion of proper alternative claim language. Yet, section 2173.05(h) (page 2100-202), merely recites examples of proper claim language ("one

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

acceptable form of alternative claim language...”), which may be representative but are not exclusive. Thus, since the Examiner has failed to establish why the “chosen from” language fails to define the metes and bounds of the Markush group, there is no legal basis to amend the claims.

The Examiner also alleges that “[s]everal of the claims employ the species as derivatives but fail to define how said materials are derived or what said materials consist [of]. It is unclear what are the scope of the derivatives contemplated.” Office Action at page 4. Respectfully, the Examiner’s objection to the term “derivatives” is misplaced. The burden is on the Examiner to establish precisely why one of ordinary skill in the art would be unable to ascertain the metes and bounds of the claimed invention, and this burden has not been met by the conclusory statements in the Office Action.

According to MPEP § 2173.02, the claims must be considered in light of, *inter alia*, the teachings in the specification. In this case, the specification provides suitable non-limiting examples of certain derivatives at, e.g., page 7, line 20. Thus, Applicant respectfully submits that this rejection is misplaced and is not in accord with proper PTO examination procedure.

The Examiner has rejected claim 84 on the basis that “[i]t is unclear how the aqueous phase may make up the continuous phase.” Office Action at page 5. The Examiner has provided no basis for this statement. Indeed, the statement of the rejection is devoid of explanation such that Applicant is unsure of how to provide a meaningful response. The burden remains with the Examiner to establish why claim 84 does not comply with § 112, and this burden clearly has not been met in this instance.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Applicant submits that claim 84 is clear and definite, both on its face and in view of the specification (e.g., see specification page 1 lines 4-8). If the Examiner chooses to maintain this otherwise deficient rejection, Applicant respectfully requests that the Examiner provide clarification and further explanation of this rejection.

V. Claim Rejections - 35 U.S.C. § 102

The Examiner has rejected claims 1, 26-37, 39-68 and 83-86 as being anticipated by Rutter et al., US 5,31,191 ("Rutter"). Office Action at pages 5-6. The Examiner asserts that "Rutter et al. discloses growth mediums[sic] that are gels comprising gellan gum and polyethylene glycol (PEG) having a molecular weight of 4000." The Examiner further asserts that activated carbon reads on the broad claim to pigments and filler. Applicant traverses this rejection.

Nevertheless, the amendments to claim 1 make this rejection moot. Accordingly, withdrawal of this rejection is earnestly solicited.

VI. Claim Rejections - 35 U.S.C. § 103

Claims 1 and 26-86 are rejected as allegedly being obvious over EP 0 803 245 A to Intercos Italia SpA ("EP '245") in view of U.S. Patent No. 5,997,887 to Ha et al. ("*Ha*"), U.S. Patent No. 5,626,853 to Bara et al. ("*Bara*"), and U.S. Patent No. 6,180,122 to Roulier et al. ("*Roulier*"), for the reasons set forth on pages 6-8 of the Office Action.

Applicant respectfully submits that the §103 rejection is improper at least because (1) the Examiner neglected to identify the requisite motivation to combine the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

remainder of the cited references, and (2) *Roulier* does not qualify as prior art pursuant to 35 U.S.C. § 103(c).

EP '245 fails to teach or suggest the present claims at least because, as admitted by the Examiner, the presently recited PEG is not disclosed. Further, the Examiner has presented no line of reasoning as to why one of ordinary skill in the art would choose gellan gum from the laundry list provided in EP '245, and there is no suggestion or motivation provided by EP '245 itself. Accordingly, Applicant respectfully submits that the Office has failed to provide specific reasoning for combining the teachings of these documents. A convincing line of reasoning must be presented as to why a skilled artisan would pick and choose various elements and/or concepts from the prior art to arrive at the claimed invention. *Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985); *In re Wesslau*, 147 USPQ 391 (Bd. Pat. App. & Inter. 1965).

At best, the Examiner provides a list from EP '245 that would be, *arguendo*, obvious to try to create a gel system, but "obvious to try" is not the standard for an obviousness rejection. The Federal Circuit has long held that choosing among a varying range of possibilities presented in the prior art, where the prior art had no indication or direction of a successful result within that range, is not obvious. *In re O'Farrell*, 853 F.2d 894, 903 (Fed. Cir. 1988); MPEP 2145 X.B. Here, the neither the reference nor the Office Action have provided motivation for choosing gellan gum from the laundry list provided in EP '245.

Ha fails to remedy the deficiencies of EP '245 for several reasons. The Examiners alleges that *Ha* is combinable with EP '245 and that *Ha*'s disclosure of a range of PEG as conditioning materials shows that "the PEG compound of varied

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

molecular weights" are "functional equivalents . . . conventional in the cosmetic art." First, *Ha* does not disclose gellan and does not disclose the presently claimed PEG. Thus, no limitations in the present claims are explicitly recited in *Ha*. Second, Applicant respectfully contends that the Examiner's statement of the functional equivalence of PEG is incorrect. In this application, the Applicant has discovered that a limited range of PEG molecular weights gives rise to a highly desirable, unique cosmetic gel product. See the specification pages 4 and 5, and claim 1. Since PEG molecular weights outside the indicated range will not provide the desired product, PEG molecular weights outside the indicated range are not functionally equivalent to those within the indicated range.

Lastly, the Examiner contends that EP '245 and *Ha* are combinable because they teach cosmetic compositions. Yet, the sole purpose of EP '245 is to provide solid gels (Abstract; Col. 1 lines 14-20) which is contrary to *Ha*, whose compositions are not solid gels (Abstract; Col. 3 lines 9-14. Col. 14 lines 51-57; Col. 39 lines 30-35). Indeed, even *Ha*'s carriers are substantially liquid. Col. 5 lines 39-41. Given the clear divergent purposes of EP '245 and *Ha*, one of ordinary skill in the art would have lacked the requisite motivation to combine their teachings. Thus, Applicant respectfully submits that neither the Examiner's statement to combine EP '245 and *Ha*, based merely upon the fact that they relate to cosmetic compositions, nor the references themselves, provide clear and particular suggestion to combine as required by the Federal Circuit.

Bara fails to remedy the deficiencies of EP '245 and *Ha*. The Examiner alleges that PEG-12 (which has a nominal molecular weight of ~600, and is referred to as PEG 600 in *Bara*) is used with other gelling agents to form solid gels, and that gellan is

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

disclosed as a gelling agent for the solid gels. However, this reference does not remedy the deficiencies of EP '245 and *Ha* for the following reasons. First, gellan is only mentioned once in the entire specification, and it is in a list of at least 17 other gelling agents. Again, the pick-and-choose and obvious-to-try rationales (as discussed above) do not meet the *prima facie* standard in an obviousness rejection. Second, PEG 600 is the only instantly claimed PEG that is mentioned (Example 1), and generic PEG is mentioned in a list of other hydrophilic polymers, with acrylic derivatives (like Carbopol 954) being preferred (Col. 4 lines 8-14; Examples 1-3). Thus, *Bara* teaches away from using PEG because of *Bara*'s preference for acrylic derivatives. Therefore, *Bara* may not be combined with other references because *Bara* itself teaches away from their combination. MPEP 2143 X.D.2; *In re Grasselli*, 713 F.2d 731 (Fed. Cir. 1983).

Finally, *Roulier* does not qualify as prior art under 35 U.S.C. § 103(c). *Roulier* appears to be available as a reference only under 35 U.S.C. § 102(e), since the international filing date of the present application is June 8, 2000, and *Roulier* issued on January 30, 2001, from an application filed on December 18, 1998.

However, because *Roulier* and the present application were subject to an obligation of assignment to, or were commonly owned by L'Oreal at the time the present invention was made, *Roulier* is not available as a reference under 35 U.S.C. § 103(c). For at least this reason, this rejection based on this reference should be withdrawn.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 5, 2003

By: 

Harry J. Guttman
Reg. No. 51,762

Enclosures:

1. "Gelatin-free system for Soft/Hard Capsules Containing Gellan Gum," Research Disclosure, GB, Industrial Opportunities Ltd. Havant, No. 332, December 1, 1991.
2. Copy of stamped PTO postcard indicating eleven documents were received.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

APPENDIX - MARKED-UP VERSION OF THE AMENDED CLAIMS

1.(Once amended) A solid aqueous gel comprising i) at least one hydrophilic gelling agent, [and] ii) at least one polyethylene glycol in which the number of moles of oxyethylene ranges from 12 to 180, and iii) at least one of (a) a fatty phase, and (b) a solvent other than water.

44. (Once amended) A gel according to claim 42, wherein the pigments coated with silicone compounds are chosen from pigments coated with polydimethylsiloxanes.

45. (Once amended) A gel according to claim 42, wherein the pigments coated with polymers are chosen from pigments coated with polyethylenes.

46. (Once amended) A gel according to claim 41, wherein the pigments are present in an amount ranging [up] from greater than 0% to 40% by weight, relative to the total weight of the gel.

50. (Once amended) A gel according to claim 41, wherein the nacreous substances are present in an amount ranging [up] from greater than 0% to 40% by weight, relative to the total weight of the gel.

53. (Once amended) A gel according to claim 41, wherein the fillers are chosen from talc, mica, silica, kaolin, powders of Nylon, poly- β -alanine and polyethylene, Teflon, lauroyllysine, starch, boron nitride, bismuth oxychloride, tetrafluoroethylene polymer powders, polymethyl methacrylate powders, polyurethane powders, polystyrene powders, polyester powders, synthetic hollow microspheres, microsponges, silicone resin microbeads, oxides of zinc and of titanium, oxides of

zirconium and of cerium, precipitated calcium carbonate, magnesium carbonate, basic magnesium carbonate, hydroxyapatite, hollow silica microspheres, glass and ceramic microcapsules, metallic soaps derived from organic carboxylic acids comprising from 8 to 22 carbon atoms, the compounds $\text{SiO}_2/\text{TiO}_2/\text{SiO}_2$, $\text{TiO}_2/\text{CeO}_2/\text{SiO}_2$, and $\text{TiO}_2/\text{ZnO}/\text{talc}$, and polyethylene terephthalate/polymethacrylate polymers in the form of flakes.

56. (Once amended) A gel according to claim 41, wherein the fillers are present in an amount ranging [up] from greater than 0% to 60% by weight, relative to the total weight of the gel.

71. (Once amended) A gel according to claim 1, [further] comprising at least one solvent chosen from ethanol, isopropanol, propylene glycol, butylene glycol, dipropylene glycol, diethylene glycol, and glycol ethers.

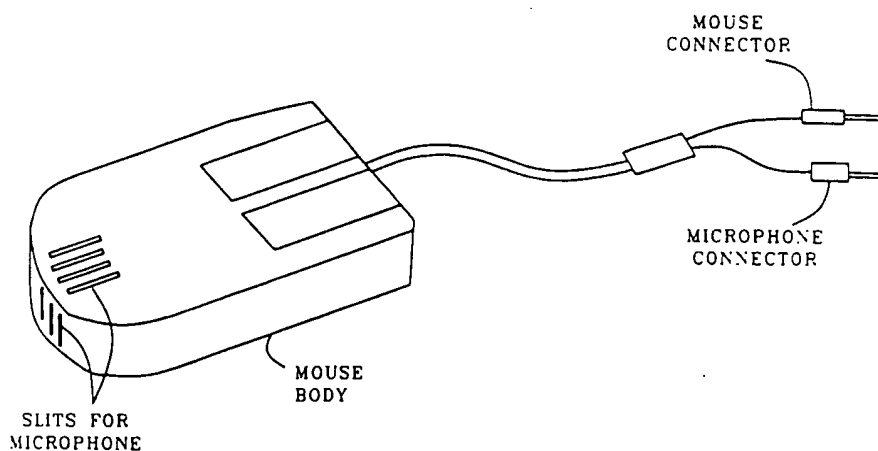
73. (Once amended) A gel according to claim 1, [further] comprising a fatty phase.

77. (Once amended) A gel according to claim 73, wherein the fatty phase is present in an amount ranging [up] from greater than 0% to 30% by weight, relative to the total weight of the composition.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

ember 1991



Disclosed anonymously
33205

33206
Gelatin-free System for Soft/Hard Capsules Containing Gellan Gum

Disclosed is a composition that can replace gelatin in forming soft/hard capsules and encapsulating films. The major component is gellan gum which can be modified with various plasticizers, e.g. glycerol, sorbitol and polyethylene glycol, as well as other polymers, e.g. sodium carboxymethyl cellulose, to produce a range of flexible and elastic films or gels for encapsulation. A two percent slurry of gellan gum in deionized water is heated to 80 °C until the gum is completely solubilized and then the plasticizer and/or polymer(s) are added with agitation and the mixture is poured onto an aluminum plate. After drying overnight at 72°F and 60% RH, the film is removed from the plate and tensile tests are performed. An example would be 2.0 wt% gellan gum and 1.0 wt% sorbitol. The tensile strength at break of a thin film (1.5 mils) is 6388 psi and 20 % elongation. Using 2.0 wt% sorbitol produces a film of 3148 psi and a 40 % elongation at break. A 300 Bloom gelatin film with 20 wt% glycerol has a tensile strength at break of 4851 psi and a 36 % elongation. A film containing 2.0 wt% gellan gum and 1.0 wt% CMC 7L had a tensile strength of 13885 psi and a 5.2% elongation.

Disclosed by
Philip E. Winston Jr.
Kelco, Division of Merck & Co., Inc.
P.O. Box 23576
San Diego, CA 92193
33206

RECEIVED

MAR -7 2003

TC 1700 MAIL ROOM

5725.0853

TLE/PAG

PLEASE STAMP TO ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

National Stage of International Application No. PCT/FR00/01577 under 35 U.S.C. 371

In re Application of: Isabelle BARA

Serial No.: 09/763,084

Filed: February 16, 2001

Group Art Unit: Unassigned

Examiner: Unassigned

FOR: AQUEOUS GEL COMPRISING A HYDROPHILIC GELLING AGENT AND A PARTICULAR POLYETHYLENE GLYCOL, COMPOSITION COMPRISING SAME AND USES

PAPERS FILED:



1. Response to Notification of Missing Requirements Under 35 U.S.C. 371/copy of Notification/executed French Language Declaration (4 pgs)/check for \$130.00
2. Submission of Assignment of Application/Recordation Form Cover Sheet/executed Assignment (2 pgs.)/check for \$40.00
3. Information Disclosure Statement Under 37 C.F.R. § 1.97(b)/Form PTO 1449 (2 pgs.)/Int'l. Search Report (2 pgs.)/Documents (11)

Dated: April 6, 2001

Client No.: 05725.0853-00000

Attorney: M. Sweet/P. Gebhardtsbauer - MD# 930

DUE DATE: APRIL 13, 2001

DID 4601 75